

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 1, 3, 5-9, 11, 13-17, 19, 21-25, 27, and 29-36 are pending in this application. Claims 1, 7-9, 15-17, 23-25, 31, 33, and 35 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent 5,341,154 to Bird, U.S. patent 6,727,917 to Chew et al. (herein "Chew"), and further in view of U.S. patent 6,552,738 to Lin et al. (herein "Lin"). Claims 3, 11, 19, 27, 32, 34, and 36 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bird, Chew, Lin, and further in view of U.S. patent Des. 409,583 to Nishida et al. (herein "Nishida"). Claims 5, 13, 21, and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bird, Chew, Lin, and further in view of U.S. patent 6,546,231 to Someya et al. (herein "Someya"). Claims 6, 14, 22, and 30 were rejected under 35 U.S.C. § 103(a) as unpatentable over Bird, Chew, Lin, Nishida, and further in view of Someya.

Addressing now the rejection of claims 1, 7-9, 15-17, 23-25, 31, 33, and 35 under 35 U.S.C. § 103(a) as unpatentable over Bird, Chew, and further in view of Lin, that rejection is traversed by the present response.

It is initially noted that each of the independent claims is amended by the present response to make a clarification. Specifically, claim 1 clarifies that "the other of the first and second operating means" is provided on the display body but outside of "and operating independently of contact with" the display screen. The other independent claims now recite similar features. According to the features clarified in each of the independent claims, the other of the first and second operating means or unit operates without contacting the display screen.

The above-noted clarified claim feature is fully supported by the original specification. As a non-limiting example the dial 32 can correspond to the claimed "the other of said first and second operating means [unit]". As clearly shown in each of the figures that

dial 32 is provided on the display body but is outside of the display screen and operates independently of contact with the display screen. That is, the dial 32 does not require any element to contact the display screen 31 to operate. Thus, the above-noted feature is fully supported by the original specification.

The above-noted feature is believed to also more clearly distinguish the claims over the applied art, particularly with respect to the reliance on the stylus 75 in Bird or the stylus in Chew to meet the above-noted limitation. As is clear from the disclosures in Bird and Chew, each stylus therein must operate to contact the display screen to operate, see for example Bird at column 7, lines 19-37, and Chew in the Abstract. Thus, the above-noted claim amendments are believed to further distinguish the claims over the applied art.

Moreover, applicants respectfully submit that the independent claims recite further features that distinguish over the applied art, in contrast to certain positions taken in the Office Action.

Independent claim 1 recites “one of said first and second operating means is provided outside of said display body and the other of said first and second operating means is provided on the display body but outside of and operating independently of contact with said display screen”. In Figure 2 buttons B1-B4, which can as a non-limiting example support the claimed “first operating means”, are formed outside of the display body, whereas the second operating means, which can as a non-limiting example correspond to the dial 32, are formed on the display body but are outside of and operate independently of contact with the display screen 31. The other independent claims recite similar features.

Applicants respectfully submit that the Office Action is still not properly considering both of the “first operating means” and “second operating means” positively recited in independent claim 1, and similarly recited in the other independent claims.

More particularly, according to the claimed features an information processing device includes both “first operating means for operating the information processing device” when a back surface of a display body is close to a main body by rotation, and such that “a system menu showing processing items” is displayed “based on an operation of said first operating means”. Thus, in claim 1 that first operating means, which can be provided outside of said display body, controls the display of a system menu. As a non-limiting example shown in Figure 2 in the present specification such a first operating means can correspond to the buttons B1-B4, which can be provided outside of said display body, and that control the display of a main menu onto a screen.

Independent claim 1 recites a further element of a “second operating means” also operable when the back surface of the display body is close to the main body, and such that “a processing item to be executed from said system menu” is displayed “based on an operation of said second operating means”. As a non-limiting example that second operating means can correspond to the dial 32 shown in Figure 2. That second operating means can be provided on the display body but outside of and operating independently of contact with the display screen, and is provided to select an item to be executed from the system menu, and again noting that the display of the system menu is controlled based on an operation of the first operating means, again as a non-limiting example by controlling buttons B1-B4 in Figure 2.

In such ways, independent claim 1 requires two separate operating devices, (1) a first that controls the display of a system menu and (2) a second that controls selecting an item in the displayed system menu. Further, both such operating devices can be operated when the display body is close to the main body by rotation. Further, one of the two separate operating devices is provided outside the display body and the other is provided on the display body but outside of and operating independently of contact with the display screen.

The above-noted features are believed to clearly distinguish over the applied art.

The outstanding rejection appears to cite the teachings in Bird to meet the limitations of both the claimed first and second operating means. Specifically, the outstanding rejection appears to reference the stylus 75 in Bird to meet the limitations of the claimed “first operating means” and appears to reference the numeric keypad 40 to meet the limitations of the claimed “second operating means”.

First, in response to that basis for the rejection applicants note the numeric keypad 40 in Bird does not control selecting an item in a displayed system menu as required by the claimed “second operating means”. With respect to that feature the outstanding Office Action states:

Bird does not explicitly disclose using the keypad to select a processing item to be executed from a system menu however it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a keypad to navigate and select the menu as it is well known in the art that a keypad can also be used as a selectable input device (# 8 key = up, #4 key = left, #6 key = right, #2 key = down and enter) (Official Notice). It would have been obvious to one of ordinary skill in the art for Bird to implement the retractable keypad as a selectable input device because it is well known in the art that a keypad can mimic the functions of a keyboard's directional arrow keys and also includes an enter key for making the selection (see Response to Arguments below).¹

In further supporting the above-noted basis for the outstanding rejection the outstanding Office Action also references U.S. patent 6,029,076 to Fiddian-Greene et al. (herein “Fiddian-Greene”) to show the functionality of a computer keypad.²

In response to the above-noted bases for the outstanding rejection, applicants traverse the rejection with the following points.

First, applicants again traverse the Official Notice, and in that respect it is unclear whether the rejection is actually utilizing the teachings in Fiddian-Greene. If that is the case

¹ Office Action of May 14, 2004, page 3, lines 9-17.

² Office Action of May 14, 2004, pages 13 and 14.

it is unclear how such teachings are relied upon and whether the Examiner is trying to utilize such teachings in a combination. Applicants submit that to not set forth a proper rejection based on the actual teachings in Fiddian-Greene is improper, and that if the Examiner wishes to utilize the teachings in Fiddian-Greene such teachings should be formally set forth in the rejection.

Applicants also note that Fiddian-Greene merely discloses setting modes of operations from a menu selected via a computer keypad, at column 25, lines 54-56.

However, what the outstanding rejection has not even attempted to address is why it would have been obvious to one of ordinary skill in the art to modify the teachings in Bird in view of such a disclosure. Specifically, why would it have been obvious to one of ordinary skill in the art to utilize the retractable numeric keypad 40 in Bird to control display of a system menu. Applicants respectfully submit that no such basis is set forth in the Office Action, as no such basis exists.

The above-noted basis for the rejection merely sets forth that such would have been obvious "because it is well known in the art that a keypad can mimic the functions of a keyboard's directional arrow keys". However such an indication does not set forth any motivation as to why one of ordinary skill in the art would utilize the retractable numeric keypad 40 in Bird to control display of a system menu. In fact, such appears to be contrary to the teachings in Bird since if anything Bird would appear to utilize the track ball assembly 50 for such a function. That track ball assembly 50 in Bird is also not covered by the display screen housing 18, and thus it would provide no benefit whatsoever in the device of Bird to utilize the numeric keypad 40 to display a system menu when Bird already has an exposed element track ball assembly 50, for that purpose.

The rationale for modifying the teachings in Bird appears to be that Bird *could* be modified to meet the claim limitations. However M.P.E.P. § 21.43.01 clearly establishes that

the mere fact that references can be modified is *not sufficient* to establish a *prima facie* case of obviousness. There must be some actual motivation to make such a modification.

There is simply no teaching in any of the cited art that would have suggested to one of ordinary skill in the art to modify Bird to utilize the numeric keypad 40 to display a system menu. Absent such a modification, the above-noted basis for the outstanding rejection is clearly an improper hindsight reconstruction of the claimed invention.

In fact, the outstanding rejection in effect sets forth by itself that it is improper as it states “the office asserts that no matter what the orientation of the display screen of Bird, the stylus and keypad of Bird *could be chosen* to be operable and effective as input devices for the system”.³

Applicants are not arguing that Bird could not have been modified to have different functions of the stylus and keypad. However, that is clearly an improper basis for the rejection. The only proper basis for the rejection is to set forth why it would have been obvious to one of ordinary skill in the art to actually modify the stylus and keypad in Bird to operate as the claimed “first and second operating means”. Absent hindsight reconstruction of applicants’ invention, there is clearly no teaching or suggestion in any of the cited references for the stylus and keypad of Bird to operate in the manner of the claimed “first and second operating means”.

Further in response to the outstanding rejection, applicants also note that the stylus 75 in Bird does not correspond to the claimed “first operating means” as the stylus 75 in Bird does not control the display of a system menu. In the claims an operation of the first operating means controls the displaying of a system menu. Clearly Bird does not teach or suggest that feature.

³ Office Action of May 14, 2004, page 15, last sentence of prenumbered point 10. (Emphasis added).

The outstanding rejection appears to recognize that the stylus 75 in Bird does not operate to select a processing item to be executed from a system menu. The outstanding rejection now appears to cite the teachings in Chew for such a feature.⁴

However, that basis for the outstanding rejection it is also deficient in several respects.

First, Chew also clearly discloses contact with a display screen to operate. The independent claims are amended by the present response to clarify the operating means provided on the display body but outside of the display screen operates “independently of contact with said display screen”. Clearly Chew does not teach or suggest such a feature, and thus Chew cannot overcome the deficiencies of Bird with respect to such a feature.

Moreover, the outstanding rejection in combining the teachings in Chew is similarly deficient in that it sets forth no proper motivation to one of ordinary skill in the art to modify Bird to operate in a manner to meet the claim limitations.

Stated another way, there is simply no teaching or suggestion in any reference to modify the stylus 75 in Bird to select a specific processing item from a system menu. The only motivation set forth in the Office Action for such a combination of teachings is “such functionally is explicitly state as well known in the art by Chew et al. (see column 5, lines 6-10)”.⁵

The above-noted motivation for such a combination of teachings is improper as it again is only based on the position that Bird could be modified to use the stylus for a different manner than Bird discloses. Again, what has not been explained in the Office Action is why one of ordinary skill in the art would modify Bird in view of such teachings in Chew. In that respect applicants again note that apparently the track ball assembly 50 in Bird is utilized for the selection of processing items from a system menu, and thus Bird has no need whatsoever

⁴ Office Action of May 14, 2004, the sentence bridging pages 3 and 4.

⁵ Office Action of May 14, 2004, page 4, lines 4-5.

to modify the stylus 75 to perform that function. Such a modification is clearly not suggested based on the teachings in the prior art themselves.

It is clear that the outstanding rejection is a hindsight reconstruction of applicants' invention based only on applicants' disclosure and not on the actual teachings in the applied art.

In such ways, applicants respectfully submit that clearly no combination of teachings of Bird, Chew, and Lin meets the limitations of any of the independent claims.

Moreover, the further rejections based on the further teachings in Nishida and Someya are also traversed by the present response as no teachings in Nishida and Someya can overcome the above-noted deficiencies of Bird in view of Chew and Lin.

Applicants also note that again the Office Action appears to take Official Notice of certain positions, and again that Official Notice is traversed. Applicants respectfully request that prior art be cited for each of the positions of Official Notice, and that particularly the cited prior art be clearly explained as to how it is part of the rejection. Applicants believe it is improper to not utilize the teachings in the references as part of the actual rejection.

In such ways, applicants respectfully submit that each of the currently pending claims is allowable.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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